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Paper No. 15

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cairo

Serial No. 75/596,169

Gerald S. Schur of Welsh & Katz, Ltd. for Matthew J. Cairo.

Andrea P. Hammond, Trademark Examining Attorney, Law Office 115
(Tomas Vlcek, Managing Attorney).

Before Seeherman, Quinn and Hohein, Administrative Trademark
Judges.

Opinion by Hohein, Administrative Trademark Judge:

Matthew J. Cairo has filed an application to register
the term "ECERTIFIED" for "providing certification of delivery
of e-mail messages and e-mail messages delivered electronically
via the world wide web."¹

¹ Ser. No. 75/596,169, filed on November 30, 1998, which is based on an
allegation of a bona fide intention to use such term in commerce.

Registration has been finally refused under Section 2(e)(1) of the Trademark Act, 15 U.S.C. §1052(e)(1), on the basis that, when used in connection with applicant's services, the term "ECERTIFIED" is merely descriptive of them.

Applicant has appealed. Briefs have been filed, but an oral hearing was not requested. We affirm the refusal to register.

It is well settled that a term is considered to be merely descriptive of goods or services, within the meaning of Section 2(e)(1) of the Trademark Act, if it immediately describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services. See *In re Abcor Development Corp.*, 588 F.2d 811, 200 USPQ 215, 217-18 (CCPA 1978). It is not necessary that a term describe all of the properties or functions of the goods or services in order for it to be considered to be merely descriptive thereof; rather, it is sufficient if the term describes a significant attribute or idea about them. Moreover, whether a term is merely descriptive is determined not in the abstract, but in relation to the goods or services for which registration is sought, the context in which it is being used on or in connection with those goods or services and the possible significance that the term would have to the average purchaser

of the goods or services because of the manner of its use. See In re Bright-Crest, Ltd., 204 USPQ 591, 593 (TTAB 1979).

Consequently, "[w]hether consumers could guess what the product [or service] is from consideration of the mark alone is not the test." In re American Greetings Corp., 226 USPQ 365, 366 (TTAB 1985).

Applicant contends in this appeal that "the record shows that ECERTIFIED is not the descriptive name of any service, but is a unitary term coined by Applicant and does not have a recognized meaning to those in the relevant field." In particular, applicant asserts that "ECERTIFIED simply has no immediate meaning to those knowledgeable in the computer communication field[,] who are accustomed to separated terms, usually joined by a hyphen, such as e-business." Applicant concedes that the Examining Attorney "has made of record numerous materials showing that 'e' means 'electronic' in the computer world" and admits that "obvious combinations of 'e' hyphenated to a noun ... may be descriptive, e.g., e-business, e-commerce, or e-conference." However, applicant argues that in this case:

[A] unified term having two or more components requires some initial mental thought or step to separate the terms before recognizing that the mark may have a meaning. Unlike a hyphenated term where the two or more terms are visually separated and more easily understood, a unified mark, such

as ECERTIFIED, by its nature requires more mental manipulation than a mark having separated terms Therefore, ECERTIFIED, requiring at least the initial mental step to separate the terms, is at most suggestive, and not merely descriptive.

Applicant further asserts, notably without citation to any authority, that:

[A] combination of terms is less likely to be merely descriptive if the term is an adjective, or the mark is a combination of terms, all of which are adjectives, as is the case with "ECERTIFIED". If the reader of the term must ask the question what noun might be applied to the adjective(s) appearing in the mark, the term cannot be descriptive. A mark which is an adjective or combination of adjectives forces the reader to complete the term with a noun in order for the mark to be understood. Therefore, in the case of "ECERTIFIED" the mark, by itself, cannot be descriptive. By the Trademark Attorney's own admission the "E" portion of the mark is an adjective meaning "electronic". The "CERTIFIED" portion is also an adjective with several dictionary meanings. The two terms in combination do not spell out for the reader what service the mark relates to, and therefore is not merely descriptive.

In addition, applicant argues that the term "ECERTIFIED" is not merely descriptive of his services because "it does not convey an immediate idea of the services or of an ingredient, quality, characteristic, function or feature of the services in connection with which it is used." Applicant urges, instead, that he has coined a mark which, since it is not a recognized descriptive term in the relevant trade or industry,

is at most suggestive of his services and therefore is registrable.

The Examining Attorney, on the other hand, contends that "applicant's arguments are unpersuasive." In particular, the Examining Attorney correctly points out that, even though "'ECERTIFIED' may be a coined term that does not yet appear in a dictionary," such a fact "is not controlling on the question of registrability," citing *In re Gould Paper Corp.*, 834 F.2d 1017, 5 USPQ2d 1110, 1112 (Fed. Cir. 1987) and *In re Orleans Wines, Ltd.*, 196 USPQ 516, 517 (TTAB 1977). As to applicant's assertions that the absence of a hyphen between the two adjectives which comprise the term "ECERTIFIED" requires a mental step in order to separate the adjectives and give meaning to the combination, the Examining Attorney maintains that:

[The adjectival term] "e," used with or without a hyphen, is a prefix meaning "electronic." Given that applicant's services are electronic certification services, no mental manipulation is required. A mark which combines descriptive terms may be registrable if the composite creates a unitary mark with a separate, nondescriptive [sic] meaning. *In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985). Though the applicant states that the outcome is different when the terms combined are adjectives, the analysis is the same. [See, e.g., *In re Pennzoil Products Co.*, 20 USPQ2d 1753 (TTAB 1991).] The combination of descriptive terms in the mark ECERTIFIED does not create a non-descriptive term. Here, "E" is defined as "electronic"; "CERTIFIED" refers to the proof that the

mail has been delivered. When considering descriptiveness in relation to the applicant's identified services, ECERTIFIED merely describes a feature of those services, namely, providing electronic certification of delivery of electronic mail.

....

The combination of "E" and "CERTIFIED" in the context of the applicant's service[s] does not create an ambiguity. The applicant's mark is a combination of two descriptive terms creating a unitary mark with the same descriptive meaning. No separate non-descriptive meaning is formed. There is no mental step required in order to readily perceive the descriptive significance of the term as it relates to certified delivery of electronic mail messages. ECERTIFIED immediately connotes certified electronic mail delivery, which is the main feature of applicant's services. Consequently, the mark is merely descriptive of applicant's services within the meaning of the Trademark Act.

Of record in support of the Examining Attorney's position are definitions of the terms "e-," "electronic mail," "certified" and "certified mail." The term "e-," according to the Official Internet Dictionary (1998) at 49, is an adjective connoting "[a]n abbreviation of 'electronic' that generally indicate[s] information or functions involving the Internet." "Electronic mail" is defined in the electronic version of The American Heritage Dictionary of the English Language (3rd ed. 1992) as "messages sent and received electronically via telecommunication links, as between microcomputers or terminals.

Also called *E-mail*," while The Computer Desktop Encyclopedia (1996) at 280 similarly lists such term as "[a]lso called **e-mail**, it is the transmission of memos and messages over a network." "Certify," as stated in the electronic version of The American Heritage Dictionary of the English Language (3rd ed. 1992), is a verb signifying, in pertinent part, "**1. a.** To confirm formally as true, accurate, or genuine." The same dictionary also defines "certified mail" as a noun denoting "[u]ninsured first-class mail for which proof of delivery is obtained." The record further contains, as applicant has acknowledged, "numerous materials showing that 'e' means 'electronic' in the computer world." Such materials consist of excerpts of articles from magazines, the world wide web or Internet, and the "Lexis/Nexis" database, and evidence use of such various terms as "e-business," "e-loan," "e-conferences," "e-campaigning," "e-commerce" and "eCommerce" as well as "e-mail."

In addition, we judicially notice, as requested by the Examining Attorney in her brief,² that the Techencyclopedia at

² Although such definitions were submitted for the first time with the Examining Attorney's brief, they are being considered inasmuch as it is settled that the Board may properly take judicial notice of definitions in dictionaries and other standard reference works. See, e.g., *Hancock v. American Steel & Wire Co. of New Jersey*, 203 F.2d 737, 97 USPQ 330, 332 (CCPA 1953); *In re Hartop & Brandes*, 311 F.2d 249, 135 USPQ 419, 423 (CCPA 1962) at n. 6; and *University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.*, 213 USPQ 594, 596 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

<http://www.techweb.com/encyclopedia/defineterm?term=e-> defines

the term "e-" as:³

(Electronic-) The "e" prefix, with or without the dash, may be attached to anything that has moved from the physical world to its electronic alternative, such as e-mail, e-commerce, e-cash, e-cards, etc. "E" words have become synonymous with the Internet.

Although many prefer to write the terms without the dash, the dash is used in this publication wherever possible, because the dash makes it easier to identify the word; for example, e-mail rather than email and e-commerce instead of ecommerce.

Such term is listed in The Oxford Dictionary of New Words (1997) at 97, which indicates that, "[f]rom the beginning of the nineties, e-, for ELECTRONIC, has been used to form words relating to the publication or exchange of information in an electronic format, such as E-MAIL, e-text (see ELECTRONIC), and e-zine (an electronically published fanzine), and words relating to electronic financial transactions, such as e-cash and e-money."

As the Board, in finding the term "E FASHION" to be merely descriptive of both "computer software for consumer use in shopping via a global computer network ... and for providing fashion, beauty and shopping advice" and "electronic retailing

³ Likewise, we take judicial notice that The Computer Glossary (9th ed. 2001) at 125 lists "e-" as meaning "(electronic-) The 'e-dash' prefix may be attached to anything that has moved from paper to its electronic alternative, such as e-mail, e-cash, etc."

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services via a global computer network featuring apparel,
fashion, accessories, personal care items, jewelry and
cosmetics," stated in the recent case of In re Styleclick.com

Inc., 57 USPQ2d 1445, 1448 (TTAB 2001) (footnotes omitted):

[W]ith each passing day, the Internet becomes more pervasive in American daily life. Many Internet words, such as "e-mail" and "e-commerce," have made their way into the general language. See: Continental Airlines Inc. v. United Air Lines Inc., 53 USPQ2d 1385 (TTAB 1999) [E-TICKET is generic for computerized reservation and ticketing of transportation services] We have no doubt that in the year 2000, the meaning of the "e-" prefix is commonly recognized and understood by virtually everyone as a designation for the Internet.

The Board, in view thereof, accordingly concluded that:

In sum, "e-," when used as a prefix in the manner of applicant's mark, has the generally recognized meaning of "electronic" in terms of computers and the Internet. When this non-source-identifying prefix is coupled with the descriptive word "fashion," the mark E FASHION, as a whole, is merely descriptive for applicant's goods and/or services. That applicant may be the first or only entity using E FASHION is not dispositive. [Citation omitted.]

Id.

Likewise, in the present case, it is our view that, when used in connection with applicant's services of "providing certification of delivery of e-mail messages and e-mail messages delivered electronically via the world wide web," the term "ECERTIFIED" immediately describes, without conjecture or speculation, a significant feature or characteristic of such services, namely, that it provides electronic certification of

delivery of e-mail messages, including those delivered electronically via the world wide web. Stated otherwise, the term "ECERTIFIED" conveys forthwith, without the need for any imagination, cogitation or the gathering of further information, that applicant provides electronic certified e-mail services. Thus, just as the term "CERTIFIED," when used in connection with ordinary or so-called "snail" mail, is a shorthand designation for "certified mail" and hence merely describes mail for which certification or proof of delivery is obtained or provided, it is readily apparent that to consumers of applicant's services, the term "ECERTIFIED," if used in relation to electronic mail services or e-mail, likewise signifies electronically certified mail and therefore merely describes e-mail for which certification of the delivery of electronic messages is provided.

Furthermore, while the presence of a hyphen separating the descriptive prefix "E-" from the descriptive term "CERTIFIED" may make it easier for some consumers to comprehend the meaning of the combined term "E-CERTIFIED," the absence of a hyphen simply does not detract or otherwise lessen the merely descriptive significance immediately conveyed by the term "ECERTIFIED," since such combinations, regardless of whether they contain a hyphen, have become synonymous with the Internet and electronic communication in general. Clearly, like the

designation "E-CERTIFIED," there is nothing in the term "ECERTIFIED" which, when considered in the context of applicant's services, is ambiguous, incongruous or susceptible to any other plausible meaning.

Accordingly, because the term "ECERTIFIED" conveys forthwith a significant feature or characteristic of applicant's services of "providing certification of delivery of e-mail messages and e-mail messages delivered electronically via the world wide web," it is merely descriptive thereof within the meaning of the statute. See, e.g., In re Styleclick.com, supra. See also, Continental Airlines Inc. v. United Air Lines Inc., 53 USPQ2d 1385, 1396-97 (TTAB 1999).

Decision: The refusal under Section 2(e)(1) is affirmed.